




# UNITED STATES PATENT AND TRADEMARK OFFICE

  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,998	09/08/2004	Patrick Rene Angibaud	PRD 2024-PCT	8833
<div>7590      06/19/2007 Philip S. Johnson Johnson &amp; Johnson One Johnson &amp; Johnson Plaza New Brunswick, NJ 08933-7003</div>			<div>EXAMINER LEESER, ERICH A</div>	
			<div>ART UNIT 1624</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 06/19/2007</div>	<div>DELIVERY MODE PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/506,998	Applicant(s) ANGIBAUD ET AL.	
	Examiner Erich A. Leeser	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 5-1-07.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 2, 4, 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9-8-04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-7 and 10-11 (in part and drawn to elected Group I) are currently pending and under examination in the instant application.

#### ***Election/Restrictions***

2. In correspondence dated May 1, 2007, Applicant elected with traverse Group I directed to claims 1-7 and 10-11 and drawn to various heterocyclic inhibitors of histone deacetylase compounds when X and Y are nitrogens and Q is carbon thereby forming pyrimidine, Z is nitrogen forming a piperazine and compositions, methods of treating and methods of preparing these compounds, classified in classes 544 and 514, subclasses 242 and 256 respectively.

Applicant unpersuasively argues that "Examiner's assertion that the defined Groups I-III are 'not so linked as to form a single general inventive concept under PCT Rule 13.1 lacks the required support.'" Each of Groups I, II and III contain a special technical feature thereby making restriction among each group proper. The special technical feature of Group I is that Z is nitrogen thereby forming a piperazine. The special technical feature of Group II is that Z is carbon thereby forming piperidine. The special technical feature of the compounds of Group III is that they are neither piperazines nor piperidines.

The requirement is still deemed proper and is therefore made FINAL.

#### ***Priority***

3. Acknowledgement is made that this application is a 371 of PCT/EP03/02514, filed on 03/11/2003, which claims benefit of 60/363,799, filed on 03/13/2002.

#### ***Information Disclosure Statement***

4. The references cited in the IDS, dated September 8, 2004, are made of record.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The following apply. Any claim not specifically rejected is rejected if it is dependent on a rejected claim and shares the same indefiniteness.

(a) Claim 5 is rejected because a claim is permitted to possess only one period at that end of the claim sentence. Because Applicant currently uses "No." to designate each compound 3-9, Applicant will have to come up with alternative designators which do not implement a period (both in the wording of the claim and in the text box showing the structure of each of these compounds). In addition, the period for this claim needs to be the final punctuation element and as such would need to appear after the text box and not before it.

Similarly, claim 10 is rejected because it does not contain a period whatsoever. Clarification is required.

(b) Claim 11 is rejected because it uses the unclear claim language "claim (I)" because a reader would not understand if Applicant intends this to mean a specific claim or a compound of Formula (I). Clarification is suggested.

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of Van Emelen, et al., copending application 10/507,785. There is significant overlap between the structure of the compounds of the instant claims and those taught by the reference. For example, the first compound listed in on page 31, compound No. 9, which reads on claims 1-3 of the reference would anticipate claims 1 and 3 of the instant application if the reference was by another and pre-dated the instant application.

Because the specification of the reference specifically teaches that the compounds of formula (I) have the identical use, one of ordinary skill would clearly find the subject matter of the instant claims to be obvious in view of the claims of the co-pending application.

This obviousness-type double patenting rejection is provisional because the conflicting claims have not in fact been patented.

### ***Claim Objections***

6. Claims 2, 4 and 6-7 are objected to as being dependent upon rejected independent claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims and rewritten to be limited to the subject matter of elected Group I.

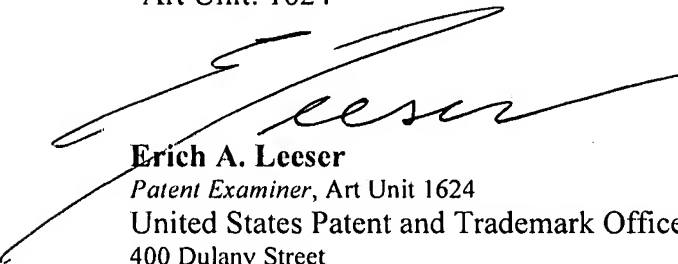
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Erich A. Leeser whose telephone number is 571-272-9932. The Examiner can normally be reached Monday through Friday from 8:30 to 6:00 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 1624



**Erich A. Leaser**

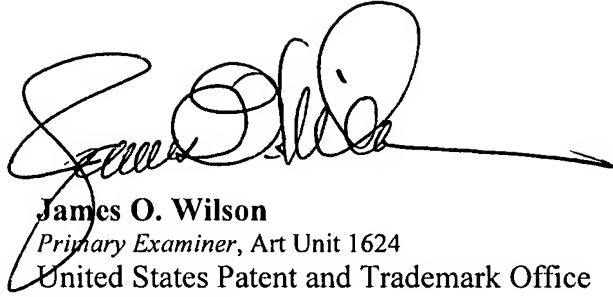
*Patent Examiner, Art Unit 1624*

United States Patent and Trademark Office

400 Dulany Street

Alexandria, VA 22314-5774

Tel. No.: (571) 272-9932



**James O. Wilson**

*Primary Examiner, Art Unit 1624*

United States Patent and Trademark Office

400 Dulany Street

Alexandria, VA 22314-5774

Tel. No.: (571) 272-0661